

REMARKS

Foreign Priority:

Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority under 35 U.S.C. § 119(a)-(d), and for confirming that the certified copy of the priority document has been received at the Patent Office.

Drawings:

Applicant thanks the Examiner for indicating that the drawings filed June 25, 2001 have been approved.

Allowable Subject Matter:

Applicant sincerely thanks the Examiner for indicating that Claims 2-18, 21, 25-27, 32 and 35 are allowed, and that although Claims 47 and 50 have been objected to, these claims would be allowable if written in independent form.

Claim Objections:

In addition to claims 47 and 50, claim 45 has been objected to for depending on a cancelled base claim 23.

Applicant has cancelled claim 45 without prejudice or disclaimer.

Claim Rejections:

Of the claims pending in the present application, claims 28-31, 33, 34, 36-43, 46, 48, 49, 58 and 59 are rejected.

Double Patenting:

The Examiner has indicated that claims 58 and 59 have very similar claim scope, and that if one of the claims is found allowable, then the other would be rejected as double patenting. Applicant has cancelled claim 59 without prejudice or disclaimer.

35 U.S.C. § 102(e) Rejection - Claims 28-31, 34 and 38-42:

Claims 28-31, 34 and 38-42 remain rejected under 35 U.S.C. § 102(e) as being anticipated by the previously applied Vembu reference. In view of the following discussion, Applicant respectfully traverses the above rejection.

In rejecting Applicant's previous arguments and discussions, the Examiner has stated that "applicant's attempt to draw a distinction between 'estimating' and 'determining' is not persuasive since the applicant's invention requires 'determining' if a criterion is met, i.e. determining whether a first calculated deviation value is greater or less than a second calculated deviation value." Office Action dated August 27, 2003, page 2, para. 2. In support of this, the Examiner appears to ignore the language of the claim regarding "estimating" and finds a reference in the present specification to "determining" a value. *See id.*

The Examiner's reference to Applicant's specification is improper for a number of reasons.

First, the passage cited by the Examiner clearly requires two estimation steps (an estimation step 23 and an estimation step 24) followed by a determination as which estimation is lower. Applicant admits that a "determination" is made in the disclosed embodiment in the specification. However, Applicant also notes that the specification is replete with instances of

where an estimation is made. It is clearly improper for the Examiner to simply assert that because at one, unrelated, portion of the specification there is a “determination” made then every instance of a recited “estimation” in the claims is really a “determination.” Stated differently, the Examiner can not read away every claimed “estimation step” simply because the specification shows at least one instance of a “determination.” This is particularly true because the specification clearly, and repeatedly, indicates that there are estimation steps involved in the present invention. Further, as is clear from the specification, one of the important features of the present invention is the use of “estimation” rather than “determination.”

Second, the Examiner is improperly reading limitations from the specification into the claims. The above claims read and require an estimation step. This is clear from the language of the claims. The claims do not recite that this step is a “determining” step. If anything, this language (referred to by the Examiner) solidifies Applicant’s distinction and recognition between “estimation” and a “determination.” Namely, because the specification sets forth both estimation steps and steps of determination, it is clear that the Applicant recognized a distinction. Therefore, it is improper for the Examiner to read every instance of “estimating” in the claims as “determining.”

Finally, Applicant notes that in view of the Examiner’s rejection, the Examiner has recognized that Vembu does not disclose an “estimating” step as claimed in the present application, but only teaches a determining step. Stated differently, the Examiner has not asserted that the Vembu determination step is an “estimation”, because the Examiner recognizes that this is not the case, but has asserted that the claimed “estimation” step is simply a

“determination” (based on some non-related language found in the specification). Thus, in view of the foregoing discussions, the Examiner’s rejection fails.

As such, Applicant respectfully submits that Vembu fails to disclose, teach or suggest each and every feature of the present invention, as set forth in claim 28. Therefore, Vembu fails to anticipate the claimed invention as required under the provisions of 35 U.S.C. § 102(e). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the present 35 U.S.C. § 102(e) rejection of this claim, and its respective dependent claims.

35 U.S.C. § 102(e) Rejection - Claims 28, 43, and 58:

Claims 28, 43, and 58 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the previously applied Kansakoski reference.¹ In view of the following discussion, Applicant respectfully traverses the above rejection.

Kansakoski discloses using a closed loop power control algorithm to adjust for Doppler shift between a moving mobile terminal 10 and a fixed base station 30. *See* Figure 4, and col. 8, lines 8-34. The disclosed power control algorithm can modify the power control commands by using an estimate of the velocity of the mobile station 10. The system further uses a power control block 72 such that “during an integration period [the] power control can be disabled and, at the end of the integration period, the power control commands can be enabled,” where the “integration period” can be a period of time where the mobile station 10 is operating in a high Doppler condition (i.e. moving at a high velocity). *See* Kansakoski, col. 12, lines 8-20.

¹ Applicant notes that claim 59 has been cancelled without prejudice or disclaimer and has, therefore, been removed from the cited rejection.

In rejecting the present claims, the Examiner asserts that Kansakoski discloses using a “different type of algorithm”, and specifically an “open loop algorithm” during de-activation. For support, the Examiner cites col. 3, line 49 to col. 4, line 13, and claim 1, of Kansakoski. Applicant has reviewed the cited portions of Kansakoski (and the remaining portions), and has found no express reference to use of an “open loop algorithm”. Further, Applicant submits that the use of an open loop algorithm is not “inherent” in the teachings of Kansakoski. Because there is no express teaching of an open loop algorithm the above rejection fails, as anticipation requires each and every element be disclosed in the prior art reference. There is no express or inherent teaching of using a different type of algorithm.

When attempting to establish the invalidity of a claim under 35 U.S.C. § 102, it must be shown that “all of the elements and limitations of the claim are found within a single prior art reference.” Scripps Clinic & Research Foundation, Revlon, Inc. v. Genentech, Inc., 927 F.2d 1565, 1576 (Fed. Cir. 1991) (citations omitted). “There must be no difference between the claimed invention and the reference disclosure,” the subject matter in the reference “must be identical in all material respects.” See Id.; and Hupp v. Siroflex of America Inc., 43 U.S.P.Q.2d 1887, 1890 (Fed. Cir. 1997). As stated above, this is not the case with regard to the pending claims as Kansakoski fails to disclose using a open loop algorithm. See supra.

Applicant does acknowledge that when a reference fails to expressly disclose each and every element of a claimed invention, as in this case, it can be argued that a reference “inherently” teaches the missing element or elements of the claimed invention. See In re Oelrich, 666 F.2d 578, 581 (Fed. Cir. 1981). However, evidence of inherency in a reference

“must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”

Continental Can Co. USA Inc. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991) (emphasis added). “Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” Id. (citing In re Oelrich, 666 F.2d 578, 581 (fed. Cir. 1981) (quoting Hansgirg v. Kemmer, 102 F.2d 212, 214 (C.C.P.A. 1939))) (emphasis in original); see also Scaltech Inc. v. Retec/Tetra L.L.C., 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Even if the prior art reference could have equally been used or made with only two possibilities, a patent claim which claims one of the two possibilities will not be anticipated because that limitation was not “necessarily” present in the prior art disclosure. See Finnigan Corp. v. I.T.C., 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference that disclosed a set-up for performing only resonance or nonresonance ejection was insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference). Thus, even if it were assumed in this case that Kansakoski can only use one of an open loop algorithm or a closed loop algorithm, this is insufficient to render this claim feature “inherent.” Thus, absent its express disclosure, Kansakoski fails to disclose, teach or suggest each and every feature of the claimed invention. There is no teaching of using a different type of algorithm.

As such, Applicant respectfully submits that Vembu fails to disclose, teach or suggest each and every feature of the present invention, either expressly or inherently, as set forth in

claims 28 and 58. Therefore, Vembu fails to anticipate the claimed invention as required under the provisions of 35 U.S.C. § 102(e). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the present 35 U.S.C. § 102(e) rejection of this claim, and its respective dependent claims.

35 U.S.C. § 102(e) Rejection - Claims 46 and 49:

Claims 46 and 49 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the newly applied U.S. Patent No. 6,519,236 to Haartsen et al. In view of the following discussion, Applicant respectfully traverses the above rejection.

Applicant submits that Haartsen is no more relevant than the Vembu reference. Specifically, Haartsen discloses “measuring” multiple RSSI values, taking an average RSSI and comparing the average with a threshold RSSI value. At no point does Haartsen disclose “estimating” an average RSSI value. Thus, Haartsen suffers from the same drawbacks as Vembu and fails to anticipate the claims for the same reason as Vembu.

Further, the Examiner asserts that the method of Haartsen “comprises regularly estimating whether a criterion is met as to whether the power control algorithm should better not be performed (estimating a RSSI and determining whether it is close to a target value).” *See* Office Action dated August 27, 2003, page 8, para 10. However, contrary to the Examiner’s assertions the determination of an RSSI value (in Haartsen) and determining whether it is close to a target value is performed in conjunction with the performing of the power control algorithm itself. This is different than the present invention. Stated differently, Haartsen is not considered with, or otherwise directed to, determining whether or not the power control algorithm should be

turned on or off. In fact, the power control algorithm in Haartsen is always on. Thus, Haartsen has little or no relevance to the claimed invention.

As such, Applicant respectfully submits that Haartsen fails to disclose, teach or suggest each and every feature of the present invention, as set forth in claim 46. Therefore, Haartsen fails to anticipate the claimed invention as required under the provisions of 35 U.S.C. § 102(e). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the present 35 U.S.C. § 102(e) rejection of this claim, and its respective dependent claim 49.

35 U.S.C. § 103(a) Rejection - Claims 33, 36 and 37:

Claims 33, 36 and 37 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Vembu, in view of “well known prior art.” In view of the following discussions, Applicant respectfully traverses the above rejection.

As an initial matter, Applicant notes that these claims depend on claim 28, and because what is “well known” does not cure the deficient teachings of Vembu with regard to claim 28, Applicant submits that these claims are also allowable, at least by reason of their dependence.

However, additionally and independently, with regard to claim 33, the claim requires an “estimated signal-to-interference ratio”. *See* claim 33. However, the Examiner only takes official notice that the use of “signal-to-interference ratios” is known. Thus, the Examiner’s argument fails to address the actual language of the claim. Specifically, the claim requires the use of an “*estimated* signal-to-interference ratio” (emphasis added). Thus, the Examiner’s official notice is of no effect and does not render the present claim obvious as it fails to teach or suggest each and every feature of the claim 33.

In view of the foregoing, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 33, 36 and 37 as required under 35 U.S.C. § 103(a). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above rejection of these claims.

35 U.S.C. § 103(a) Rejection - Claim 48:

Claim 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Haartsen in view of “well known prior art.” In view of the following discussions, Applicant respectfully traverses the above rejection.

As an initial matter, Applicant notes that these claims depend on claim 46, and because what is “well known” does not cure the deficient teachings of Haartsen with regard to claim 46, Applicant submits that this claim is also allowable, at least by reason of its dependence.

However, similar to claim 33, claim 48 requires an “estimated signal-to-interference ratio”. However, the Examiner only takes official notice that the use of “signal-to-interference ratios” is known. Thus, the Examiner’s argument fails to address the actual language of the claim. Specifically, the claim requires the use of an “*estimated* signal-to-interference ratio” (emphasis added). Thus, the Examiner’s official notice is of no effect and does not render the present claim obvious as it fails to teach or suggest each and every feature of the claim 33.

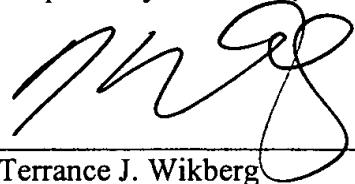
In view of the foregoing, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 48 as required under 35 U.S.C. § 103(a). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above rejection of this claim.

Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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